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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,495	10/31/2000	Allen Louis Gorin	112233-CONT 2	8836
23838	7590	04/07/2005	EXAMINER	
KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005			PHAN, JOSEPH T	
			ART UNIT	PAPER NUMBER
			2645	
DATE MAILED: 04/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/699,495

Applicant(s)

GORIN ET AL.

Examiner

Joseph T Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/28/04, 2/14/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The second application must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See Transco Products, Inc. v. Performance Contracting, Inc., 38 F.3d 551, 32 USPQ 2d 1077 (Fed. Cir. 1994).

More specifically the subject matter of non-verbal speech in the claims of the present invention are not disclosed in the parent application. Therefore new subject matter is disclosed in the present application and cannot claim the priority date over the parent application. More explanation is provided below in 'response to arguments' section.

Specification

2. The attempt to incorporate subject matter into this application by reference to "On automated language acquisition, J.Acoust. Soc. Am., 97 3441-3461, (June 1995) [hereafter referred to as Gorin 95]" on page 5 of applicant's present disclosure and also by reference to "Spoken Language Acquisition for Automated Call Routing....[hereafter Gorin 94A] on page 6 of present disclosure are both improper because the information and pages as cited toward the reference on pages 5 and 6 are not found within the disclosure. It is not known if the references are a publication,

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article, or textbook to be located.

The independent claimed subject matter also pertains to information (i.e. non-verbal and multimodal inputs) pointed towards these references.

Appropriate correction is required to continue further with the examination and search process.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-54 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

More specifically in independent claims 1 and 28, the specification does not described the generation of meaningful phrases from verbal and non-verbal speech in line 4. It merely points toward an improper incorporation of a reference with improper usage (eg. "See page numbers" on page 6 lines 4 and 8 of specification). The generation of meaningful phrases from verbal and non-verbal speech must be enabled or reduced to practice in the disclosed specification.

Additionally, the dependent claims also contain subject matter that the specification does not described in such a way to enable one skilled in the art to make and/or use the invention (e.g. Dependent claim 2 discloses phrases that are expressed in multimodal

form, the specification does not disclose phrases expressed in multiple forms, and dependent claim 5 discloses non-verbal speech as one of gestures, body movements, cable box entries, etc. which is not taught by the specification.)

Claim 8 discloses focus of attention which can include eye movement, body position, etc., it is not known what is described by user's focus of attention.

Claim 14 discloses operating within the internet, cable TV network, or wireless network, etc.).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 6, 27, 28, 31, 33, and 54 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "non-verbal speech" in claims 1, 4, 6, 27, 28, 31, 33, and 54 is unclear and confusing which renders the claim indefinite. The specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

As claimed, gestures, body movements, head movements are not speech, the term speech can be interpreted as words or spoken sounds but not movements, etc that are silent. The 'Gorin paper' discloses as one example, visual and focus of attention inputs, which is contradictory to 'non-verbal speech'.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-55 rejected under 35 U.S.C. 103(a) as being unpatentable over Gorin et al., publication "Automated Call Routing in a Telecommunications Network", 2nd IEEE workshop on Interactive Voice Technology for Telecommunications Applications, Kyoto Research Park, Kyoto, Japan, September 26-27, 1994 pages 137-140 in view of Blattner et al., "Multimedia Interface Design", ACM Press, New York, New York, 1992.

Regarding independent claims 1 and 28, Gorin et al, teaches means for determining a plurality of meaningful phrases from verbal speech each of the meaningful phrases being generated based on one of a predetermined set of the task objectives (page 138 col.1 paragraphs 2 and 3);

a recognizer that recognizes at least one of the meaningful phrases in an input communication of the user (page 138 Fig.2 phrase detector based on input communication of a user and page 138 col.1 paragraph 3, spoken input);

a task classifier that makes a classification decision in response to the recognized meaningful phrases relating to one of the set of predetermined task objectives (page 137, col.1 paragraph 2, *'appropriate action is to connect to an automated subsystem'*);

a task router that routes the user's request in order to perform at least one of the

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task objectives based on the classification decision (page 137, paragraph 2, *'the machine needs to understand the spoken language to route the call appropriately'*).

Gorin does not expressly disclose input recognition from non-verbal speech.

Blattner teaches, as best understood due to the 112 problems above, input recognition from non-verbal speech (pages 133-135, sections 8.5, 8.5.1 and 8.5.2)

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use non-verbal speech (e.g. gestures) as input recognition for routing systems. One of ordinary skill in the art would have been motivated to do this as Blattner discloses using gesture interpretation (eg. eye movements as stated in claim 5 of applicant's present invention) for input recognition (Blattner page 134 paragraph 1). This would allow a user to use multiple forms of input communications and not based only on speech input.

Response to Arguments

6. Applicant's arguments filed 02/06/2003 have been fully considered but they are not persuasive.

Priority can not be claimed for a plurality of reasons as indicated above with detailed explanation below:

The "Gorin paper", incorporated within Patent #5,675,707, in which applicant argues discloses the claimed invention, does not enable nor reduced to practice "a generator that generates a plurality of phrases from verbal and non-verbal speech...". The paper merely discloses that Sankar, not Gorin, **proposes** the construction of *sensory primitive subnetworks* which is not enablement nor reduction to practice.

The 'Gorin paper' is furthermore invalid to claim priority for a plurality of reasons including;

In addition to the 'Gorin Paper' not enabling the current claimed limitations nor showing reduction to practice, the cited references in the 'Gorin paper' discloses two people (Sankar and Henis, page 3443 and 3450) that are not part of the current application's inventive entity. There are different inventive entities for each application disclosed and therefore cannot claim priority over another different inventive entity.

Per MPEP 2163.02, applicant must either enable one to make/and or use the invention, actual reduction to practice, or that the invention was complete by identifying sufficient evidence to show that the applicant was in possession of the claimed invention.

It is further noted that the Declaration of priority filed with the application is incorrect, as the current application -495 is not a continuation but a continuation-in-part of the parent application 08/943,944 since there are different inventive entities and that application '944 does not disclose nor enable the current claimed limitations of 'generation of phrases from non-verbal speech.

From these reasons the current application is not entitled to the priority date of the parent applications.

Applicant also states that during the personal interview on February 5th, 2003, Examiners J.Phan and F.Tsang understood the claimed terminology and a demonstration of the Gorin Paper was performed. Examiners disagrees as applicant attempted to clarify the claimed invention but nothing was agreed upon as more research and consideration was needed. It is also noted that the demonstration

presented was of a different embodiment(*showed a user using voice recognition to find location-specific information while traveling*) than the claimed "generation of phrases from non-verbal speech" and also, nonetheless, the video did not show or prove the claimed priority date.

Therefore, the current pending application is only entitled to the date as filed on 10/31/2000 and the 103 and 112 rejections are proper.

Conclusion

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

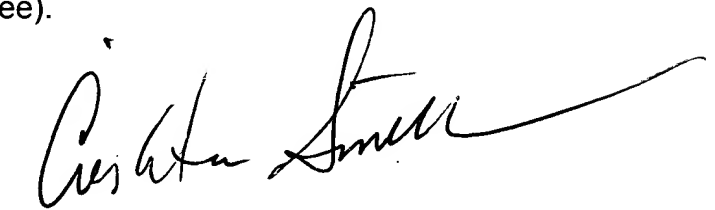
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is (571) 272-7544. The examiner can normally be reached on M-TH 9:00-6:30, in every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTP
March 30, 2004



**CREIGHTON SMITH
PRIMARY EXAMINER**